

REMARKS

The Office Action dated March 20, 2007, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto.

Claims 21-37 are currently pending in the application, of which claims 21, 30, and 39 are independent claims. Claims 21-37 are respectfully submitted for consideration.

The drawings were objected to because they allegedly do not show all of the features of the claims. The Office Action, however, did not identify any features of the claims that are absent from the figures. Accordingly, it is respectfully requested that this objection be withdrawn, because it does not identify any particular defect in the drawings.

Claims 30-47 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, because the application as originally filed allegedly did not disclose "a software tool to be performed the functions of the claims." Applicants respectfully traverse this rejection.

Although the specification does not use the phrase "software tool," the specification does describe "an arrangement and a method" at page 1, line 35, an arrangement is contrasted with a "manual work" at page 1, lines 27-32, and the arrangement is described as including "modules" at page 2, lines 28-30. Accordingly, one of ordinary skill in the art would understand that the term "arrangement" as used in the specification broadly encompassed a software tool. Thus, claims 30-47 clearly were

possessed by Applicants at the time of the invention, and it is respectfully requested that the rejection be withdrawn.

Claims 21-47 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite because the term “technical solutions” is “vague and indefinite because it’s unclear what it’s constituted for.” Applicants respectfully traverse this rejection.

The term “technical solutions” is described in the specification at, for example, page 3, lines 1-8. The fact that the term “technical solutions” is a broad term does not imply that it is an indefinite term.

One of ordinary skill in the art would understand the metes and bounds of the invention conveyed by the term “technical solutions.” The term “technical solutions” is composed of two words, “technical” and “solutions.” The word “technical” is an adjective that describes the type of solutions, and specifies that those solutions are in the technological arts. The word “solutions” is a plural noun that describes the resolution of a problem. Accordingly, one of ordinary skill in the art would understand that “technical solutions” refers to technological resolutions to problems, and would, therefore, understand the metes and bounds of the invention.

The above explanation has been provided for the purpose of illustration, and should not be viewed as limiting the invention. The claims describe the scope of the invention.

The Office Action requested: “Please clarify, so the meter [sic] and boundary of the claims can be determined.” It is respectfully submitted that the explanation provided

above ought to suffice. The term “technical solutions” is broad, and it should be construed in the broadest reasonable manner consistent with the specification. Accordingly, it is respectfully requested that the rejection of claims 21-47 be withdrawn.

The Office Action also took the position that claims 21, 30, and 39 were to be rejected under 35 U.S.C. 112, second paragraph, as being indefinite because of the phrase “providing a comparison of different technical solutions to a user based on the modeling,” and this rejection was accompanied by the same request for clarification as above. Applicants respectfully traverse this rejection with clarifying remarks.

The phrase “providing a comparison of different technical solutions to a user based on the modeling,” is definite. One of ordinary skill in the art reading the phrase in light of the specification would understand that the phrase “providing a comparison of different technical solutions to a user based on the modeling,” describes a comparison being made between various technological ways of resolving a problem. For example, a comparison could be made between carrying an IP packet stream in optical channels or carrying the IP packet stream in coaxial cable channels, which are two alternative technical solutions for the problem of providing a physical communication channel to carry an IP packet stream.

To some degree, it appears that the rejection of claims 21, 30, and 39 is based on the use of the term “technical solutions” in those claims. Accordingly, it is respectfully submitted that the explanation provided above may also show the definite scope of claims

21, 30, and 39. For all the reasons above, therefore, it is respectfully requested that this rejection be withdrawn.

Claims 21-47 were rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter because they are “not limited practical application.” This rejection is legally incorrect, and it is respectfully requested that this rejection be withdrawn.

The Office Action appears to have misunderstood the legal standard of utility. The legal requirement is that the claimed invention be useful (35 U.S.C. 101), novel (35 U.S.C. 102), and non-obvious (35 U.S.C. 103). There is a legal presumption that any claim is useful, novel, and non-obvious, and in contradicting patentability, the burden lies on the U.S.P.T.O. to establish unpatentability. “Utility” or “usefulness” does not have to be recited in a claim any more than “non-obviousness” has to be recited. This is abundantly clear from the fact that it is permissible to have claims to articles of manufacture and compositions of matter. Such claims do not recite a utility (the use of the invention is not recited in the claims), but yet they claim a useful invention because the claim an article or manufacture or composition of matter whose use is apparent from the specification.

With regard to claim 21, the claim recites a method, which is, on its face, statutory subject matter because 35 U.S.C. 101 indicates that “process” is one statutory category of invention. Furthermore, the claim does recite a concrete, tangible, and useful result, namely, for example, “providing a comparison of different technical solutions to a user based on the modeling.”

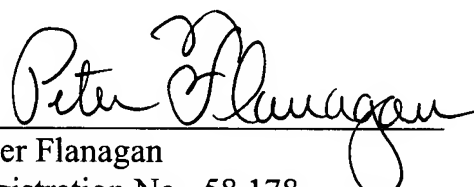
Accordingly, Applicants cannot agree with the Office Action's position that claim 21 (or claims 22-29 that depend therefrom) lacks utility. Claims 30 and 39 (and their respective dependent claims 31-38 and 40-47), which each recite "a tool," are both clearly patentable subject for the reasons explained above, and additionally because claims 30 and 39 are directed to a machine and/or article of manufacture, which are both clearly recited as statutory subject matter in 35 U.S.C. 101. Accordingly, it is respectfully requested that this rejection be withdrawn.

For the reasons set forth above, it is respectfully submitted that each of claims 21-37 recites subject matter that is definite, supported by the written description, useful, novel, and non-obvious. Accordingly, it is respectfully requested that all of claims 21-37 be allowed, and that this application be passed to issuance.

If, for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,


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